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PPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
10/614,432	10/614,432 07/07/2003		Roger D. Tung	VPI/98-101 CIP CON DIV 2579 US		
27916	7590	11/21/2006		EXAMINER		
VERTEX F		ACEUTICALS INC	O SULLIVAN, PETER G			
					PAPER NUMBER	
,				1621	1621	
				DATE MAILED: 11/21/2006	S	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/614,432	TUNG ET AL.					
Office Action Summary	Examiner	Art Unit					
	Peter G. O'Sullivan	1621					
The MAILING DATE of this communication appeared for Reply	ears on the cover sheet with the c	orrespondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION  16(a). In no event, however, may a reply be tim  ill apply and will expire SIX (6) MONTHS from to become ABANDONEE	l. ely filed the mailing date of this communication. D (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on	_•						
•							
·	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
	x parte Quayre, 1905 C.D. 11, 40	0 0.0. 210.					
Disposition of Claims							
4)⊠ Claim(s) <u>1-38</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.	loction requirement	· · ·					
8)⊠ Claim(s) <u>1-38</u> are subject to restriction and/or e	riection requirement.						
Application Papers							
9) The specification is objected to by the Examine							
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the o							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.					
Priority under 35 U.S.C. § 119	·						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:							
1. Certified copies of the priority documents have been received.							
2. Certified copies of the priority documents have been received in Application No							
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list		d					
See the attached detailed Office action for a list	of the certified copies not receive	u.					
Attachment(s)							
1) Notice of References Cited (PTO-892)	4) Interview Summary						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da 5) Notice of Informal P						
3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	6) Other:	war is business.					

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-34, drawn to heterocyclic containing compounds, classified in class 544, subclass 336+.
- II. Claims 1-20 and 23-34, drawn to non-heterocyclic containing but sulfonamide or sulfonyl carbazate containing compounds, classified in class 564, subclass 81+.
- III. Claims 1-34, drawn to non-heterocyclic containing but not sulfonamide or sulfonyl carbazate containing compounds, classified in class 564, subclass 152+.
- IV. Claims 35-37, drawn to methods of inhibiting serine protease or treating hepatitis, classified in class 514, subclass 252+.
- Claim 38, drawn to processes for making applicants' compounds,
   classified in class 564, subclass 133+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case hepatitis C can be treated with interferon alpha.

Inventions I-III and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

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process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case applicants' compounds could be made by reacting a sulfonyl chloride with a suitable amine or by reacting a carbonyl halide with an amine to form an amide group other than that formed in applicants' process.

Inventions I-III are distinct in that each group is disparate structurally so that a reference anticipating one would not necessarily render the others obvious.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Applicants are further required to elect a single disclosed species, i.e. a single compound, if one of groups I-IV is elected.

A telephone call was made to Ms. Dixon on or about 8 November 2006 in which she agreed to receive a written restriction.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

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distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter G. O'Sullivan whose telephone number is (571)272-0642.

PETER O'SULLIVAN PRIMARY EXAMINER GROUP 1200

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